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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,461	02/20/2001	Masahiro Nozaki	P 277124 T36-129082M/AIO	5463
23400	7590	03/18/2005	EXAMINER	
POSZ LAW GROUP, PLC 11250 ROGER BACON DRIVE SUITE 10 RESTON, VA 20190			STRIMBU, GREGORY J	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/785,461

**Applicant(s)**

NOZAKI, MASAHIRO

**Examiner**

Gregory J. Strimbu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,8-10,12-17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Election/Restrictions***

Applicant's election with traverse of restriction requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that subject matter of all of the species is sufficiently related that a thorough search for the subject matter of any one species would necessarily encompass a search for the remaining species. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as set forth in chapter 800 of the MPEP. It is a well established practice that a requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct (i.e., capable of supporting separate patents). See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct are obvious in view of one another. Applicant's response implies that the various species are not considered to be patentably distinct. If this is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is therefore made FINAL.

Claims 6, 7, 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 2, 2002, October 1, 2003 and Jun3 1, 2004 have been approved.

***Claim Rejections - 35 USC § 112***

Claims 2, 4-5, 8-10, 12-17 and 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "which is adjacent to and integral with the proximal end of the flange part" on lines 7-8 of claim 10 render the claims indefinite because it is unclear with respect to what structure the proximal and distal ends of the flange part are defined. Recitations such as "a trim" on line 13 of claim 10 render the claims indefinite because it is unclear if the applicant is referring to the trim set forth above or is attempting to set forth another trim in addition to the one set forth above. Also see "one seal lip of the pair of seal lips" on lines 17-18 of claim 10, "opposing sides" on line 19 of claim 10, and "a single integral component" on line 6 of claim 14 which suffer from the same informality. Recitations such as "or" on line 2 of claim 20 render the claims indefinite because it is unclear which one of the two non-equivalent alternatives the applicant is attempting to positively set forth.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5, 8-10, 12, 14-17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in figure 11 and Japanese Patent Publication No. 4-130514.

The admitted prior art in figure 11 discloses a trim and glass run attachment structure in a vehicle door comprising, a flange part (not numbered, but seen in figure 11) provided on a window frame 13 of the vehicle door, wherein the window frame is comprised by an inner panel 15, an outer panel 16 and a door sash 17, and the flange part is comprised by a portion of the window frame at which an interior flange 15b of the inner panel and an interior flange 17a of the door sash are joined together and to which a trim 31 is mounted, a U-shaped attachment groove 17c, which is adjacent to and integral with the proximal end of the flange part, wherein the U-shaped attachment groove is on an exterior side of the proximal end of the flange part and is on an outer peripheral side of the proximal end of the flange part, a lock protrusion strip 17d provided on a wall of the attachment groove that is on an interior side of the attachment groove, and the lock protrusion strip 17d is at the proximal end of the flange part, and a glass run 31a, wherein the glass run has a glass run body (not specifically numbered, but shown in figure 11) attached to the attachment groove, wherein the glass run body

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includes opposing side walls (not numbered, but shown in figure 11) and a pair of seal lips 31b and 31c, one seal lip 31b of the pair of seal lips being on the door interior side of the window glass and one seal lip 31c of the pair of seal lips being on the door exterior side of the window glass, and wherein the seal lips are structured to engage opposing sides of a window glass 14, and wherein the glass run body has a lock protrusion strip (not numbered, but shown in figure 11) engaging with the lock protrusion strip of the attachment groove to retain the glass run body in the groove, and a door exterior part of the flange part and a door interior part of the attachment groove are integrally formed as a single component, and wherein the flange part and attachment groove are formed in series and are partitioned by the lock protrusion strip of the attachment groove and the glass run has a U-shaped structure. The admitted prior art of figure 11 is silent concerning a glass run formed separately from the trim.

However, Japanese Patent Publication No. 4-130514 discloses a trim and glass run attachment structure comprising a trim 4 formed separately from a glass run 3 wherein a part of the trim (not numbered, but seen in figure 1) is in contact with part of the glass run when the trim is attached to a flange part 14.

It would have been obvious to one of ordinary skill in the art to provide the admitted prior art of figure 1 with a trim formed separately from the glass run, as taught by Japanese Patent Publication No. 4-130514, to increase the performance of the glass run attachment structure since each of the trim and the glass run can be made of a material better suited for its particular application.

***Allowable Subject Matter***

Claims 13 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach an opening formed between the trim and the glass run in the corner due to a difference in radius of curvature between the trim and the glass run, and the opening is covered with a shielding plate located outside of a side wall of the trim. See lines 2-4 of claims 13 and 22.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baumann and Vollmer are cited for disclosing a shielding plate.

***Response to Arguments***

Applicant's arguments filed March 1, 2005 have been fully considered but they moot in view of the new grounds of rejection.

***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Gregory J. Strimbu', with a long horizontal flourish extending to the right.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
March 15, 2005